

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 10/580,076 Confirmation No.: 4917
Applicant : Kathleen D'HALLUIN, *et al.*
Filed : May 18, 2006
Title : IMPROVED TARGETED DNA INSERTION IN PLANTS
TC/Art Unit : 1638
Examiner: : Cathy Kingdon WORLEY
Docket No. : 58764.000062
Customer No. : 21967

MAIL STOP PATENT TERM EXT.

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. § 1.705(b)**

Dear Sir:

Applicants request reconsideration under 37 C.F.R. § 1.705(b) of the patent term adjustment of 232 days indicated for the above-identified application ("the '076 application"). It is respectfully requested that Applicants be granted a minimum patent term adjustment of at least 277 days.

The issue fee is being paid concurrently with this paper. Accordingly, this request is timely. *See* 37 C.F.R. § 1.705(b).

In accordance with 37 C.F.R. § 1.705(b)(1), please charge the fee set forth in 37 C.F.R. § 1.18(e) (\$200) to the undersigned's **Deposit Account No. 50-0206**. In the event any additional fees are required for consideration of this request, the USPTO is authorized to charge these fees to the undersigned's Deposit Account No. 50-0206.

Remarks begin on page 2.

REMARKS

Applicants request reconsideration under 37 C.F.R. § 1.705(b) of the patent term adjustment for the '076 application. In view of the following, it is respectfully requested that Applicants be granted a minimum patent term adjustment of at least 277 days.

Statement Under 37 C.F.R. § 1.705(b)(2)

The patent term adjustment ("PTA") under 35 U.S.C. § 154(b) listed on the '076 application is 232 days. See **Exhibit A** (a copy of the Determination of Patent Term Adjustment). This determination is in error because the USPTO failed to take certain action within the time frame specified in 37 C.F.R. § 1.702(a) and failed to issue a patent within three years of the actual filing date of the above-identified patent application in accordance with 37 C.F.R. § 1.702(b). See *Wyeth v. Dudas* 88 USPQ2d 1538 (D.D.C. 2008).

A. *Wyeth v. Dudas*

In *Wyeth v. Dudas*, the U.S. District Court for the District of Columbia considered the USPTO's interpretation of 35 U.S.C. § 154(b). This section provides three guarantees of patent term adjustment, two of which are at issue. The first is a one-day extension of patent term for every day that issuance is delayed due to the USPTO failure to comply with certain statutory deadlines such as fourteen months for a first office action. See 35 U.S.C. § 154(b)(1)(A)(i)-(iv); see also 37 C.F.R. § 1.702(a). These delays are called "A delays" or "A periods." The second adjustment is a one-day term extension for every day it takes the patent to issue after three years from the filing date. See 35 U.S.C. § 154(b)(1)(B); see also 37 C.F.R. § 1.702(b). The period that begins after the three-year window has closed is referred to as the "B delay" or the "B period."

Under the statute, if "A delays" and "B delays" overlap, "the period of adjustment granted ... shall not exceed the actual number of days the issuance of the patent was delayed." 35 U.S.C. § 154(b)(2)(A) The purpose of this section is to prevent "double-counting" of periods of delay. See *Wyeth*, 88 USPQ2d at 1539. According to the USPTO's interpretation of this section, any "A delay" overlaps with any "B delay," and thus an applicant can only get credit for an "A delay" *or* a "B delay," whichever is larger, but never for both. *Id.* at 1540. The court disagreed. It concluded that periods of time "overlap" *only* if they occur on the same day. *Id.* at 1541. Therefore, if an "A delay" and a "B delay" occurs on a different day, then a patentee may obtain an extension of A + B days. *Id.*

B. Calculation of PTA Under 37 C.F.R. § 1.703 Under *Wyeth*

The following facts are relevant for determining PTA for the '076 application.

- May 18, 2006 – '076 application is filed.
- April 6, 2009 – mail date of notice of allowance.
- May 18, 2009 – three years from filing date of application (i.e., beginning of “B period”).
- July 6, 2009 – due date for payment of issue fee.

1. “A” Periods Under 37 C.F.R. § 1.702(a)

The USPTO’s delay from May 18, 2006 to April 6, 2009—i.e., prior to the “B period”—is 263 days. *See* USPTO Patent Term Adjustment History, attached herewith as Exhibit B.

2. “B” Periods Under 37 C.F.R. § 1.702(b)

The number of days from the beginning of the “B period” (May 18, 2009, i.e., three years from the filing day of the application) to the end of the proposed “B period” (July 6, 2009, i.e., assuming the patent issues on the due date for payment of the issue fee) is 45 days.

3. Delay Attributed to Applicant

The USPTO has calculated Applicants’ delay in this case as 31 days. *See* USPTO Patent Term Adjustment History.

4. $PTA = (A \text{ Period} + B \text{ Period}) - \text{Applicants Delay}$

According to *Wyeth*, the PTA should be calculated as follows:

A period = 263 days. *See* 1. above

B period = 45 days. *See* 2. above.

Applicants’ delay = 31 days. *See* 3 above.

$(263 + 45) - 31 = 277$ days

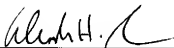
Accordingly, Applicants respectfully request that the '076 application be granted a minimum PTA of at least 277 days.

In view of the above remarks, it is respectfully requested that this Request for Reconsideration of Patent Term Adjustment be favorably considered and that a corrected Determination of Patent Term Adjustment be issued to reflect a minimum patent term adjustment of at least 277 days.

Respectfully submitted,
HUNTON & WILLIAMS LLP

Date: July 6, 2009

By: _____



Robert M. Schulman
Registration No. 31,196

Alexander H. Spiegler
Registration No. 56,625

HUNTON & WILLIAMS LLP
Intellectual Property Department
1900 K Street, N.W., Suite 1200
Washington, D.C. 20006
(202) 955-1500 (telephone)
(202) 778-2201 (facsimile)

Exhibit A

**UNITED STATES PATENT AND TRADEMARK OFFICE**

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22315-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,076	05/18/2006	Kathleen D'Halluin	58764.000062	4917
21967	7590	04/06/2009		
HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109			EXAMINER WORLEY, CATHY KINGDON	
			ART UNIT 1638	PAPER NUMBER
			DATE MAILED: 04/06/2009	

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)
(application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 232 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 232 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

Exhibit B

10/580,076 TARGETED DNA INSERTION IN PLANTS

07-06-
2009::11:45:18**Patent Term Adjustments**

Patent Term Adjustment (PTA) for Application Number: 10/580,076

Filing or 371(c) Date:	05-18-2006	USPTO Delay (PTO) Delay (days):	263
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	31
Post-Issue Petitions (days):	+0	Total PTA (days):	232
USPTO Adjustment(days):	+0	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
04-06-2009	Mail Notice of Allowance	238	
04-02-2009	Document Verification	↑	
04-02-2009	Notice of Allowance Data Verification Completed	↑	
04-02-2009	Examiner's Amendment Communication	↑	
03-17-2009	Case Docketed to Examiner in GAU	↑	
08-25-2008	Case Docketed to Examiner in GAU	↑	
06-03-2008	Date Forwarded to Examiner	↑	
04-11-2008	Response after Non-Final Action		31
04-11-2008	Request for Extension of Time - Granted		↑
04-03-2008	Mail Examiner Interview Summary (PTOL - 413)		↑
03-26-2008	Examiner Interview Summary Record (PTOL - 413)		↑
12-11-2007	Mail Non-Final Rejection	25	
12-10-2007	Non-Final Rejection	↑	
08-26-2007	Case Docketed to Examiner in GAU	↑	
05-18-2006	Information Disclosure Statement considered	↑	
08-14-2006	Information Disclosure Statement considered	↑	
07-18-2007	Date Forwarded to Examiner	↑	
07-16-2007	Response to Election / Restriction Filed	↑	
07-16-2007	Request for Extension of Time - Granted		
05-15-2007	Mail Restriction Requirement		
05-11-2007	Requirement for Restriction / Election		
02-01-2007	IFW TSS Processing by Tech Center Complete		
02-01-2007	Case Docketed to Examiner in GAU		
08-14-2006	Information Disclosure Statement (IDS) Filed		

08-14-2006	Information Disclosure Statement (IDS) Filed		
05-18-2006	Request for Foreign Priority (Priority Papers May Be Included)		
05-18-2006	Reference capture on IDS		
05-18-2006	Information Disclosure Statement (IDS) Filed		
05-18-2006	Information Disclosure Statement (IDS) Filed		
05-18-2006	Preliminary Amendment		
05-18-2006	371 Completion Date		
09-07-2006	Application Dispatched from OIPE		
06-06-2006	CRF Is Good Technically / Entered into Database		
06-05-2006	Cleared by OIPE CSR		
05-18-2006	CRF Disk Has Been Received by Preexam / Group / PCT		
05-18-2006	Initial Exam Team nn		

Close Window